

REMARKS

Introduction

Applicant would like to thank the Examiner for indicating that claims 6, 10-17, and 21-23 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this Response, Applicant has amended claims 1, 5, 7, and 21, cancelled claims 3 and 4, added claims 25-27, and addressed the Examiner's objections and rejections. Support for the amendments to the claims can be found throughout the application. Accordingly, no new matter has been added. Amendments to the claims are being made solely to expedite prosecution and do not constitute an acquiescence to any of the Examiner's objections or rejections. Applicant's silence with regard to the Examiner's rejections of the dependent claims constitutes a recognition by the Applicant that the rejections are moot based on the Applicant's Amendment and Remarks relative to the independent claim from which the dependent claims depend. Applicant reserves the option to further prosecute the same or similar claims in the present or a subsequent Application.

Claim Objections – 35 U.S.C. § 112

The Examiner rejected claims 1-24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner objected to the use of the phrase "and/or" in claims 1 and 4. Applicant has removed the use of "and/or" in claim 1 and has cancelled claim 4. Additionally, the Examiner objected to the use of the phrase "may be" in claim 5. Applicant has removed the use of "may be" in claim 5. Further, the Examiner objected to claims 7 and 21 as defining a narrower limitation in an already defined limitation with the reference of "preferably"

within the same claim. As the Examiner suggested, Applicant has added new claims 26 and 27 which include the narrower limitation in dependent form. Applicant therefore kindly asks the Examiner to remove the objections under 35 U.S.C. §112.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 1-5, 7, 9, 18-20, and 24 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Number 3,408,250 to Finefrock (“Finefrock”). The Examiner also rejected claims 1 and 8 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Number 5,195,2887 to Bruggink (“Bruggink”).

However, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131; *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). “Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.” *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999). Importantly, “[t]he mere fact that a certain thing *may result* from a given set of circumstances is insufficient to prove anticipation.” *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048 (Fed. Cir. 1994).

Applicant’s independent claim 1 is directed to a finishing unit for floor covering. Among other things, independent claim 1 recites a floor covering facing front part wherein the front part is provided with attaching means suitable for attaching the finishing unit to the floor covering.

Finefrock neither discloses nor suggests a **front part provided with attaching means** suitable for attaching the finishing unit to the floor covering as claim 1 recites. Instead, Finefrock discloses a baseboard molding having a pressure sensitive adhesive on its **wall-contacting** surface. (*see* Finefrock: column 1, lines 14-15). Finefrock’s molding is merely

applied at the intersection between the wall and the floor and no floor covering is applied to its front part. As such, Finefrock does not disclose or suggest a front part provided with attaching means suitable for attaching the finishing unit to the floor covering as claimed in claim 1. Finefrock cannot, therefore, and does not anticipate claim 1.

Additionally, Bruggink neither discloses nor suggests a **front part provided with attaching means** suitable for attaching the finishing unit to the floor covering as claim 1 recites. Instead, Bruggink discloses raceway panels having removable cut-outs that provide access to the wiring behind. (*see* Bruggink, column 1, lines 22-25). As such, Bruggink does not disclose or suggest a front part provided with attaching means suitable for attaching the finishing unit to the floor covering as claimed in claim 1. Bruggink cannot, therefore, and does not anticipate claim 1.

For at least the foregoing reasons, because Finefrock and Bruggink fail to disclose or suggest a front part provided with attaching means suitable for attaching the finishing unit to the floor covering as claim 1 recites, Applicant respectfully submits that claim 1 is allowable. Additionally, since claim 1 is allowable, claims 2-5, 7-9, 18-20, and 24 depending therefrom are also allowable.

Based on the foregoing Remarks, Applicant traverses the Examiner's rejection of claims 1-5, 7-9, 18-20, and 24 under 35 U.S.C. 102(b).

CONCLUSION

In view of the foregoing, the application is now believed to be in condition for formal allowance. Prompt and favorable action is respectfully requested. Should any additional fee be required in connection with the submission of this document, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,

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